

## **REMARKS**

### **I. Overview**

These remarks are set forth in response to the Non-Final Office Action.

Presently, claims 1 through 29 are pending in the Patent Application. Claims 1, 10 and 20 are independent in nature. In the Non-Final Office Action, the Examiner has rejected claims 1 through 29 under 35 U.S.C. § 112, second paragraph. Additionally, Examiner has rejected claims 1, 10-11 and 20-21 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication 2004/0254792 by Busayapongchai et al.

(Busayapongchai), and the Examiner has rejected 2-5, 12-15 and 22-25 under 35 U.S.C. § 103(a) as being unpatentable over Busayapongchai in view of U.S. Patent No. 6,269,336 to Ladd et al. (Ladd). Yet further, the Examiner has rejected 6-8, 16-18 and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over Busayapongchai in view of U.S. Patent No. 6,341,959 to Wen et al. (Wen). Finally, the the Examiner has rejected 9, 19 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Busayapongchai and Ladd in view of U.S. Patent No. 6,915,254 to Heinze et al. (Heinze).

### **II. The Applicant's Invention**

The Applicants have invented a method and system of identifying and optimizing audio segments in a speech application program. In the Applicants' invention, audio segments are identified and extracted from a speech application program. The audio segments containing audio text to be recorded are then optimized in order to facilitate the recording of the audio text. The optimization of the extracted audio segments may include accounting for programmed pauses and variables in the speech application code,

identifying multi-sentence segments and the presence of duplicate audio segments, and accounting for the effects of co-articulation.

### III. Rejections Under 35 U.S.C. § 112, Second Paragraph

On page 4 of the Non-Final Office Action, Examiner argues that claims 1, 11 and 21 specify an audio recordation plan for audio segments to be recorded by a voice professional comprises “file names of recorded audio files of the planned audio segments” which makes uncertain how audio files that have not yet been recorded can be considered to have “file names of recorded audio files.”

Applicants have reviewed claims 1, 11 and 21 and can find no reference to “voice professional”. Further, the plain language of claims 1, 11 and 21 is clear: An audio recordation plan includes a file of planned audio segments and corresponding file names of recorded audio files of the planned audio segment. Thus, the FILE lists PLANNED AUDIO SEGMENTS and CORRESPONDING FILE NAMES OF RECORDED AUDIO FILES of the PLANNED AUDIO SEGMENT.

As Examiner knows, there are two separate requirements set forth in 35 U.S.C. § 112, second paragraph. As described in M.P.E.P. 2171, (A) the claims must set forth the subject matter that applicants regard as their invention; and (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. The first requirement is a subjective one because it is dependent on what the Applicants regard as their invention. The second requirement is

an objective one because it is not dependent on the views of applicant or any particular individual, but is evaluated in the context of whether the claim is definite - i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.<sup>1</sup> As such, if the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate.<sup>2</sup> However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant.<sup>3</sup>

In the instant case, the claim language of claims 1, 11 and 21 could not be more clear as to what is required for the recordation plan. Further, with respect to claims 21 through 29, Examiner has provided no evidence that one of skill in the art would not

---

<sup>1</sup> See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

<sup>2</sup> See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993)

<sup>3</sup> M.P.E.P. 2173.02

recognize that a computer having a central processing unit that performs a series of steps would not inherently include memory as Applicants are aware of no computer with a central processing unit that does not inherently include memory even with the central processing unit itself (e.g. registers on chip). Thus, in both cases, Examiner in the absence of evidence to the contrary as opposed to mere opinion, has not proven that a person of ordinary skill in the art could not interpret the metes and bounds of the claims so as to understand how to avoid infringement as required by 35 U.S.C. § 112, second paragraph.

#### IV. The Rejections on the Art

##### A. Characterization of Cited Art

Busayapongchai relates to methods and systems for automating the assembly or creation of audio files for providing to listeners or for use in voice interactive services are provided. In Busayapongchai, a voice application script is prepared and text associated with a desired audio file statement is inserted in the voice application in place of an audio file name. A recording manager software program passes the voice application script to an Extensible Markup Language (XML) parser that locates audio file tags in the voice application script. The XML parser extracts voice properties, if any, for each found audio tag, such as age and gender properties. The XML parser extracts the **text string**, and the recording manager software module passes the text string and associated properties in a database query to an audio file recording library database for locating an audio file matching the text string and properties. If a matching audio file or combination of audio files is located, a file name for the located file or files may be populated into the

voice application script so that upon execution of the voice application script, the located audio file will be called by the script for presentation to a user or for use in a voice interactive services system.

## B. Argument

In the Amendment submitted concurrently with the RCE under Rule 114 on July 21, 2008 (the “Amendment”), Applicants argued that Busayapongchai did not account for an audio recordation plan as expressly claimed in Applicants’ claims. Specifically, Applicants argued:

Examiner's articulate reasoning set forth on pages 3 and 4 of the Final Office Action refer to Busayapongchai, paragraphs [0028-0031] and [0039] in support of the notion that Busayapongchai teaches the processing of an extracted audio segment to create an audio text recordation plan as recited in Applicants' claims 1, 11 and 21. It is true that audio text is extracted from VXML script in Busayapongchai and it is further true as Examiner observes that in Busayapongchai, when a suitable audio file cannot be found for extracted text, a manual audio recordation can be performed to produce a suitable audio file. Specifically, it is stated in paragraph [0039] of Busayapongchai, "if the developer does not find the combination of located audio file references acceptable or otherwise satisfactory...a manual development process may be performed by the developer."

Applicants have amended claims 1, 11 and 21 to clarify that an audio recordation plan is "a file of planned audio segments and corresponding file names of recorded audio files of the planned audio segments" as described in connection with Applicants' Figure 2 on paragraph [0024] and paragraph [0025] of Applicants' specification. Busayapongchai--particularly paragraph [0039] of Busayapongchai does not contemplate the use, creation or maintenance of an audio recordation plan as set forth in amended claims 1, 11 and 21. Rather, at best paragraph [0039] refers to the identification of audio text for which a new recording must be made. The use of an "audio recordation plan" as described in paragraph [0024] of Applicants' specification, can be used advantageously by a teleprompter program designed to display text for recording and saving the recording as a file.

In response, in the Non-Final Office Action, Examiner interprets Applicants’ arguments to mean that “paragraph [0039] of Busayapongchai only refers to the planned audio text segments, and thus, fails to teach the claimed recordation plan that also includes file names.”

Examiner misinterprets Applicants' arguments. Applicants clearly set forth that Applicants' claims require the presence of an "audio recordation plan" defined as a file of planned audio segments and corresponding file names of recorded audio files of the planned audio segments. Examiner believes that because Busayapongchai describes the text "hello world" as having a corresponding "audio file of the same name", the "file name is also included in the extracted information". Examiner's arguments miss the boat. The plain claim language requires an audio recordation plan that includes each of:

- (1) a file of planned audio segments
- (2) file names of recorded audio files
- (3) the recorded audio files correspond to the planned audio segments.

In the Amendment, Applicants particularly demonstrated the distinctive nature of an "audio recordation plan" by stating, "The use of an 'audio recordation plan' as described in paragraph [0024] of Applicants' specification, can be used advantageously by a teleprompter program designed to display text for recording and saving the recording as a file."

Despite Applicants' efforts to teach the difference between an audio recordation plan and text in a VoiceXML script to be correlated with pre-recorded audio, in the Non-Final Office Action, Examiner continues to compare "audio recordation plan" to (1) text in a VoiceXML script; and (2) a recorded audio file corresponding to the text. To properly support a rejection based upon anticipation, the Examiner must go much further. Specifically, Examiner must locate an audio recordation plan that includes a FILE of

PLANNED AUDIO SEGMENTS, each with a corresponding FILE NAME of a RECORDED AUDIO FILE that corresponds to one of the PLANNED AUDIO SEGMENTS. Examiner's "file" is a VoiceXML script that does not include a listing of file names for recorded audio each that CORRESPONDS to an audio segment also listed in the file. Thus, Examiner has not accounted for all elements claimed and cannot satisfy a prima facie case of anticipation let alone obviousness.

V. Conclusion

The Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §§ 101, 102(e) and 103(a) owing to the amended claims and the foregoing remarks. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date: January 11, 2009

/Steven M. Greenberg/

Attorney at Law, Reg. No.: 44,725  
Attorney for Applicant(s)  
Carey, Rodriguez, Greenberg & Paul, LLP  
950 Peninsula Corporate Circle, Suite 3020  
Boca Raton, Florida 33487  
**Customer No. 46322**  
Tel: (561) 922-3845  
Fax: (561) 244-1062